

REMARKS1. Present Status of Patent Application

In response to the non-final office action dated February 6, 2006, Applicants respectfully request reconsideration based on the following remarks. Applicants respectfully submit that the claims as presented are in condition for allowance. Applicants encourage the Examiner to contact the undersigned agent if any issues remain that need to be resolved.

2. Response To Rejections of Claims Under 35 U.S.C. §103

In the Office Action, claims 21 and 26 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Hendrey* (U.S. Patent Publication No. 2002/0102993). Claims 22-25 and 27-30 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Hendrey* in view of *Goldhaber* (U.S. Patent No. 5,794,210). It is well-established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly or explicitly, all elements/features/steps of the claim at issue. *See, e.g., In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

a. Claims 21 and 26

As provided in independent claim 21, Applicants claim:

A method of sending an advertisement to a user operating a wireless communication device, comprising:

sending first information about a location of the user to a content provider that provides web content to the wireless communication device;

sending an indication to the content provider when the location is continuously changing;

searching a first database containing a plurality of location-specific advertisements;

selecting a first one of the plurality of location-specific advertisements that is associated with the location of the user and is desired to be sent to the user at a stable location that is not continuously changing; and

sending the first one of the plurality of location-specific advertisements to the wireless communication device over a communication network when the location is stable and not continuously changing.

(Emphasis added).

Applicants respectfully submit that independent claim 21 is allowable for at least the reason that *Hendrey* does not disclose, teach, or suggest at least the features of "sending an indication to the content provider when the location is continuously changing . . . selecting a first one of the plurality of location-specific advertisements that is associated with the location of the user and is desired to be sent to the user at a stable location that is not continuously changing; and sending the first one of the plurality of location-specific advertisements to the wireless communication device over a communication network when the location is stable and not continuously changing," as recited and emphasized above in claim 21.

Rather, *Hendrey* discloses: "Advertising tracking system 105 [that] further comprises a location tracking subsystem 132. Tracking subsystem 132 uses location information provided by telecommunication system 120 to monitor the geographic location of a plurality of [mobile telecommunication units] MUs 110 served by the telecommunication system 120. The locations may then be compared to a database of predetermined locations as beneficial to the operation of generation subsystem 131. For example, tracking subsystem 132 notifies tracking manager 130 when a user is near a particular business that desires to advertise for customers, and may also notify tracking manager 130 when a user has entered a particular business's store location." See para. 0031.

Hendrey further states: "Advertising tracking system 105 further comprises a location-sensitive advertising generation subsystem 131 that is capable of generating relevant advertising content given the location of a user and the business(es) relevant to that location. For example, if a particular user is close to a store having a sale that includes goods typically purchased by that user, generation subsystem 131 may create an advertisement stating that a particular set of goods relevant to the user is on sale at the relevant nearby store. The determination of when to send advertisements may be based on a profile associated with each user. The profile may specify the user's interests, types of advertisements he or she desires to receive, times of day that the user does/does not want to receive advertisements, and like information. The distance within which a MU must be with respect to a store before an advertisement is fired to the MU may be any predetermined distance, for example fifty meters, and may vary by MU, by store, or the like." See para. 0032.

The Office Action states that "Hendrey does not explicitly disclose that the advertisements are sent when the user's location is stable. However, Hendrey discloses tracking the user being both moving and stable (see above citations), that particular indications concerning advertisements can be made when the user's location is stable at certain areas ([47]), that the various features and embodiments of the Hendrey disclosure can be utilized for targeting advertisements ([53]), that there are many variations and factors for targeting a user [(32, 33, 34, 58)] and that there are many possible variations of the Hendrey disclosure ([66])." Pages 3-4. The Office Action therefore alleges that it would be obvious for the information in Hendrey's Fig. 1, including whether the user is moving or the location is stable, to be utilized for targeting the user. See page 4. Applicants respectfully disagree.

For example, with respect to Fig. 1 of *Hendrey*, it shows an MU 110, a store 100, a telecommunication system infrastructure 120 with processor 107, prospect tracking manager 130, location sensitive advertising content generator 131, location tracking subsystem 132, and advertising effectiveness database 133. This by itself does not suggest or teach tracking a location of a user, determining whether the location is constantly changing, and sending advertisements which are desired to be sent when the location is determined to be stabled and not constantly changing. Regarding paragraphs 0053 and 0066 cited above, they do not disclose tracking when the user's location is constantly changing or stable. Regarding paragraph 0058 cited above, it discusses identifying distances and "whether a particular user is close enough to a predetermined location to be likely to respond to an advertisement." As such, this passage does not disclose tracking when the user's location is constantly changing or stable. Regarding paragraphs 0032-0034 cited above, these passages discuss the distance within which an MU is within a store before an advertisement is sent. Regarding paragraph 0047 and gauging responsive to advertising content (see paras. 0045-0046), paragraph 0047 states:

A first technique is to monitor the general location of MU 110 over a period of time to see if traveling of the prospect ceased in the general vicinity of store 100 even if insufficient positioning accuracy is available to determine whether the prospect visited the store or merely stopped nearby it. This provides suggestive evidence that the advertisement caused the user of MU 110 to stop and shop at store 100 even if no purchase is recorded or there is insufficient information to tie a purchase to the user of MU 110. Preferably, such cessation of motion is screened for false alarms if the area in which such cessation took place was

historically common, for example indicating the location of the user's work or home location.

This fails to teach or contemplate suggesting "selecting a first one of the plurality of location-specific advertisements that is associated with the location of the user and is desired to be sent to the user at a stable location that is not continuously changing; and sending the first one of the plurality of location-specific advertisements to the wireless communication device over a communication network when the location is stable and not continuously changing," as recited in claim 21. Further note that paragraph 0053 referenced previously states, "Another variant of the embodiments discussed above is a system that creates and sends advertising content, but does not track the effectiveness of advertising (i.e., incorporates the elements of FIG. 1 except for effectiveness database 133, and has an operation corresponding only to steps 201, 202, and 210 in FIG. 2)." Thus, a system described in paragraph 0053 is a system that sends advertising content in a manner described with respect to FIG. 1, but does not include the tracking steps with respect to tracking effectiveness of advertising, such as that described with respect to paragraph 0047.

Hendrey seemingly teaches the sending of advertisements based on proximity of a MU to a store or other location. *Hendrey* provides no suggestion or teaching for sending of advertisements based on whether a location of a MU or user is constantly changing. Although *Hendrey* may evaluate the effectiveness of a previously sent advertisement by examining whether traveling of a MU has ceased at a location, this is distinct from the methodology taught by *Hendrey* for sending advertisements. Accordingly, the requisite motivation for modifying the *Hendrey* reference is believed to be lacking.

Applicants submit that a *prima facie* case of obviousness has not been established, since a reference has not been cited that discloses at least "selecting a first one of the plurality of location-specific advertisements that is associated with the location of the user and is desired to be sent to the user at a stable location that is not continuously changing; and sending the first one of the plurality of location-specific advertisements to the wireless communication device over a communication network when the location is stable and not continuously changing," as recited in claim 21. The Office Action states that it would be obvious to modify the *Hendrey* reference to include a claimed limitation without providing any support to show that the claimed limitation has been previously disclosed or is known. It is noted "To establish *prima facie* obviousness of a

claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Rayka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *see also* MPEP 2143.03. Further to establish a *prima facie* case of obviousness, "impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art."

As such, *Hendrey* fails to establish a *prima facie* case of obviousness, and the rejection of claim 21 and claim 26 which depends therefrom should be withdrawn, for at least this reason.

b. Claims 22-25 and 27-30

Because independent claim 21 is allowable over the cited art of record, dependent claims 22-25 and 27-30 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that dependent claims 22-25 and 27-30 contain all the steps and features of independent claim 21 and the cited art of *Goldhaber* fails to remedy the deficiencies of the *Hendrey* reference. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Additionally and notwithstanding the foregoing reasons for allowability of claims 22-25 and 27-30, these claims recite further features and/or combinations of features (as is apparent by examination of the claims themselves) that are patentably distinct from the cited art of record.

CONCLUSION

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

For at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,


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